

REMARKS

Claims 1-10 are pending and under consideration.

ITEMS 3-4: ALLOWABLE SUBJECT MATTER

Claims 6-10 are allowed. (Action at page 4).

Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant appreciates the indications of allowable subject matter. However, claims 4-5 are not rewritten in independent form since patentability is deemed to reside in independent claim 1 and from which claims 4-5 depend.

ITEM 1: REJECTION OF CLAIMS 1-2 UNDER 35 U.S.C. §102(e) AS BEING ANTICIPATED BY CHEN ET AL. (U.S.P. 5,149,090)

Claims 1-2 are rejected under 35 U.S.C. §102(e) as being anticipated by Chen.

Independent claim 1 recites a damping apparatus including "a first member joinable to a first object; a second member joinable to a second object; and a vibration absorbing member installed between the first and second members, wherein at least one of the first and second members has elastic hooks that are elastically catchable by respective edge portions of the corresponding object for joining the member to the corresponding object."

As provided in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must discuss every aspect of a claimed invention. Chen does not support an anticipatory-type rejection by not discussing features recited in independent claim 1.

Chen does not discuss for example a vibration absorbing member installed between a separate first member and a separate second member.

The Examiner contends that an elongated band 20 merely having ends 21,22 discusses a vibration absorbing member, a separate second member, and a separate third member.

Applicant respectfully submits that the three members, i.e., a vibration absorbing member, a separate second member, and a separate third member are not discussed by a single band 20 discussed in Chen (for example, col. 2, lines 50-60).

Summary

Since features recited by claims 1-2 are not discussed by Chen, the rejection should be withdrawn and claims 1-2 allowed.

ITEM 2: REJECTION OF CLAIM 3 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER CHEN IN VIEW OF SHINODA ET AL (US PAT. 4,873,149)

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of

Shinoda

Dependent claim 3 recites a damping apparatus "wherein at least one of the first and second members is made of a stainless steel plate plated with nickel substantially preventing effects of electromagnetic interference."

The Action concedes that Chen does not discuss these features. However, the Examiner contends it would be obvious to modify Chen with "to utilize the first and second members is made of a stainless steel plate plated with nickel of Shinoda et al into Chen et al's plate in order to prevent effects of vibration-damping." (Action at page 2).

As set forth in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."

Applicant submits that *prima facie* obviousness is not established since none of the art relied on by the Examiner, alone or in an *arguendo* combination, discuss "preventing effects of electromagnetic interference."

Chen merely discusses a sports racquet. Shinoda discusses an apparatus having a flexible mounting mechanism. An *arguendo* combination of Chen and Shinoda discusses a sports racquet having a flexible mounting mechanism.

Applicant submits there is no motivation or reasonable chance of success to modify as the Examiner contends. As provided in MPEP §2144. 04:

(t)he mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

The Examiner contends that the band 20 discussed by Chen (see, for example col. 2 lines 50-60) "made of elastic flexible material" could be modified so as to have ends made of stainless steel plate plated with nickel "to prevent effects of vibration damping."

Applicant submits there is no suggestion in Chen to modify an elastic band of a sports racquet "such as common tennis racquet" with stainless steel plate. let alone to modify a tennis racquet preventing effects of electromagnetic interference.

Summary

Since *prima facie* obviousness is not established, the rejection should be withdrawn and claim 3 allowed.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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